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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,906	01/23/2004	Janet Marie Jewell	22864-00002	1905

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EXAMINER

FERNSTROM, KURT

ART UNIT PAPER NUMBER

3714

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/707,906

Applicant(s)

JEWELL, JANET MARIE

Examiner

Kurt Fernstrom

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-18, 20 and 21 is/are rejected.  
7) ☒ Claim(s) 19 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9, 10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai in view of Morrissey. Lai discloses in Figure 1 and in column 2, line 18 to column 4, line 18 of the specification a device comprising a writing board 1 having removable fasteners 4 disposed along the edge thereof. While the fasteners 4 are not clips, Official Notice is taken that clips are a well known attachment means, and would have been an obvious variation on the suction cups disclosed by Lai to allow the user to attach the board to an object. Lai fails to disclose that the writing board comprises a support board with a notepad attached thereto. Morrissey discloses in Figures 1-7 and in column 2, line 56 to column 4, line 45 of the specification a device comprising a support board 28 which is removably attachable to an object, and a notepad assembly 10 attached to the support board. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Lai as viewed in combination with Morrissey by providing a notepad on the board for the purpose of allowing the user to write notes on sheets of paper. With respect to claim 2, Morrissey discloses in Figure 4, lines 16-29 that the notepad assembly is adhesively attached to

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the support board. With respect to claims 4, 5, 9 and 12, Morrissey discloses a notepad having the claimed features. With respect to claims 6 and 13, Official notice is taken that spiral-bound notebooks are well known, as acknowledged on page 4 of applicant's specification, and would have been an obvious means of binding the pages of the notepad together. With respect to claims 7 and 10, Lai discloses in Figure 1 that a writing utensil 3 is releasably connected to the board.

Claims 8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai in view of Morrissey, and further in view of Lopez. Lai as viewed in combination with Morrissey discloses all of the limitations of the claims with the exception of the use of a hook and loop fastener to attach the writing utensil to the board. Lopez discloses in Figure 3 and in column 3, lines 14-20 of the specification a device comprising a writing board, wherein a writing utensil is attached to the board with a hook and loop fastener. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Lai as viewed in combination with Morrissey by providing a hook and loop fastener for the writing utensil for the purpose of allowing the user to easily attach and remove the writing utensil from the board.

Claims 14, 15 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lai in view of Morrissey, and further in view of Schaefer. Lai as viewed in combination with Morrissey discloses all of the limitations of the claims with the exception of the storage unit. Schaefer discloses in Figure 1 and in column 2, lines 6-63 of the specification a storage device configured for storing a variety of items, including clipboards, file folders and the like. With respect to claim 18, Schaefer further

discloses that a plurality of dividers are provided in the storage device. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Lai as viewed in combination with Morrissey by providing a storage unit for the purpose of conveniently storing one or more writing boards when not in use. With respect to claim 15, Lai discloses in Figure 1 that a writing utensil 3 is releasably connected to the board. With respect to claim 17, Schaefer discloses in Figure 1 a box construction. With respect to claim 18, while two note boards as recited in claim 14 are not disclosed by Schaefer, the various writing devices that are disclosed by Schaefer, including the clipboard, the citation book, and the file folders are all considered to be analogous to note boards in that each is used to write things down. Also, Schaefer further discloses that a plurality of dividers are provided in the storage device.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lai in view of Morrissey and Schaefer, and further in view of Robson. Lai as viewed in combination with Morrissey and Schaefer discloses all of the limitations of the claims with the exception of the writing utensil which is releasably connected to the storage unit. Robson discloses in Figure 1 and in column 2, lines 52-66 of the specification a storage device 10 configured for storing a notepad 28, whereby a writing utensil 50 is releasably attached to the storage unit. It would have been obvious to one of ordinary skill in the relevant art to modify the device disclosed by Lai as viewed in combination with Morrissey and Schaefer by providing a writing utensil which is releasably connected to the storage unit for the purpose of allowing a user convenient access to a writing utensil as needed.

***Allowable Subject Matter***

Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed on July 26, 2004 have been fully considered but they are not persuasive. With respect to the rejection of claims 1-13, applicant does not appear to have directly addressed the Official Notice taken concerning the use of clips rather than the suction cups of Lai. Instead, the response merely argues that clips are not disclosed by Lai or Morrissey. In further support of the Official Notice taken, Anthony, Ainley, Beaver, Davis, Deralas, Ohkubo, Perry, and Franks have all been cited in support of the contention that clips are a well known attachment means for items and an obvious variation on the suction cups disclosed by Lai, particularly given that all of the aforementioned references, and Lai, are directed to items which are attachable in a car. While none of the references disclose the attachment of the items to a book, as argued by applicant, there is no recitation in the claims of attachment of the device to a book. A clip is an obvious means of attaching the device within a car, and thus the invention as claimed is obvious in light of the prior art.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

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combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is well known in the prior art that various types of notepads and writing boards are well known. In particular, pads of paper are well known, and have certain advantages over a wipe-off board such as the ability to save and transport notes which have been written. One of ordinary skill would have known about this variation on a writing board, and would have known to provide it in a structure comprising a writing board, such as Lai.

Applicant's arguments with respect to claims 14-18 and 20 have been considered but are moot in view of the new ground(s) of rejection. Because new grounds of rejection have been presented herein, this action is made non-final.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Anthony, Ainley, Beaver, Davis, Deralas, Ohkubo, Perry, and Franks disclose various items which are attachable in a car via clips. Dunning and Lykens disclose devices for storing notepads, having writing utensils releasably attached thereto.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF  
April 20, 2004



**KURT FERNSTROM  
PRIMARY EXAMINER**